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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,301	03/18/2004	Nikhil Jain	030259U2	7810
23696	7590	01/13/2006	EXAMINER	
QUALCOMM, INC 5775 MOREHOUSE DR. SAN DIEGO, CA 92121			BHATTACHARYA, SAM	
			ART UNIT	PAPER NUMBER
			2688	

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/804,301	Applicant(s) JAIN ET AL.	
	Examiner Sam Bhattacharya	Art Unit 2688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20050829</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 2, 7, 12 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Aisenberg (US Patent Application Publication No. 2004/0116155 A1).

Regarding claims 1, 7, 12 and 17, Aisenberg discloses a general global gateway 82 configured to support communication between a GSM network and a CDMA network to enable a mobile station (MS) 50 subscribed in the GSM network to communicate using the CDMA network, comprising: a database 20 configured to store a number of times the mobile station has accessed the GGG; and a logic unit 83 configured to execute program logic to determine whether a parameter is received from the mobile station, the parameter representing a count of a predetermined event that is a mutually agreed upon event between the GGG and mobile station. See FIG. 11, paragraph [0002], lines 1-9 and paragraph [0046], lines 1-29.

Regarding claim 2, Aisenberg discloses that the count represents the number of times the mobile station has accessed the GGG, equal to the stored number of times the mobile station has accessed the GGG. See paragraph [0046], lines 14-23.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 3, 6, 8, 11, 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aisenberg in view of Raffel et al. (US 5,675,629).

Regarding claims 3, 8 and 13, Aisenberg fails to disclose determining whether a registration notification from the mobile station was received before a timer expires.

However, Raffel et al. discloses a mobile registration system in which a control mechanism determines whether a registration notification from the mobile station was received before a timer expires. See col. 27, lines 18-27. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the mobile system of Aisenberg by relating a registration notification to a timer, as taught by Raffel et al., to decide whether to continue with other processes in the mobile system.

Regarding claims 6, 11 and 16, Aisenberg fails to disclose a location register configured to store a location of the mobile station to enable a call incoming to the mobile station from the GSM network to route the incoming call to the mobile station through the GGG.

However, Raffel et al. disclose a mobile system in which a location register performs storing of mobile location and routes incoming calls to the mobile network through a gateway. See col. 35, lines 24-37. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the mobile system of Aisenberg by including a location register, as taught by Raffel et al., so that mobile locations can be properly tracked as mobiles move from network to network.

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5. Claims 4, 9, 14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aisenberg in view of Saito et al. (US Patent Application Publication No. 2001/0044295 A1).

Regarding claims 4, 9, 14 and 18, Aisenberg fails to disclose a timer that is used by the GGG to determine a period of time in which the mobile station is authorized to communicate with the GSM network.

However, Saito discloses a mobile system in which a timer is used to determine a period of time in which the mobile station is authorized to communicate with the network. See paragraph [0074]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the mobile system of Aisenberg by relating an authentication to a timer, as taught by Saito, to increase the chances of warding off unauthorized accesses to the system.

6. Claims 5, 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aisenberg in view of Hartmaier (US Patent Application Publication 2004/0137899 A1).

Regarding claims 5, 10 and 15, Aisenberg fails to disclose a short message service center (SMSC) configured to send and receive SMS messages to and from the CDMA network.

However, Hartmaier discloses a mobile system in which disclose a short message service center that sends and receives SMS messages to and from CDMA network 240. See FIG. 2 and paragraph [0025]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the mobile system of Aisenberg by including a short message service center, as taught by Hartmaier, so that short messages in addition to voice calls can be communicated over networks having different protocols.

Response to Arguments

7. Applicant's arguments filed 10/6/05 have been fully considered but they are not persuasive.

Applicant argues that Aisenberg's backup system does not internetwork between a CDMA network and a GSM network and that Aisenberg also does not disclose a mobile station (MS) subscribed in the GSM network to communicate using the CDMA network, as set forth in claims 1, 7, 12 and 17.

Examiner respectfully disagrees. The preambles of claims 1, 7, 12 and 17 broadly recite communicating between a GSM network and a CDMA network. However, none of the claims recite internetworking between the GSM network and the CDMA network, as argued by Applicant. It has been held that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Accordingly, Examiner suggests that Applicant amend the claims to recite the limitation for which Applicant argues.

Moreover, the recitation of a mobile station subscribed in the GSM network to communicate using the CDMA network has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA

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1951). Accordingly, Examiner suggests that Applicant move the recitation to the body of the claims in order to accord it patentable weight.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Bhattacharya whose telephone number is (571) 272-7917. The examiner can normally be reached on Weekdays, 9-6, with first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sb


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SUPERVISORY PATENT EXAMINER